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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,092	08/04/2003	Dean H. Vogler	CML01263H	5887

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EXAMINER	
NGUYEN, MINH DIEU T	

ART UNIT	PAPER NUMBER
2137	

NOTIFICATION DATE	DELIVERY MODE
01/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.Schaumburg@motorola.com
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Office Action Summary	Application No.	Applicant(s)	
	10/634,092	VOGLER ET AL.	
	Examiner	Art Unit	
	Minh Dieu Nguyen	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-18* is/are pending in the application.

4a) Of the above claim(s) *12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 13-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This office action is in response to the communication dated 10/31/07.

2. Claims 1-11 and 13-18 are pending. Claim 12 has been cancelled.

Response to Arguments

3. Applicant's arguments filed 7/17/2007 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 2 and 6 are objected to because of the following informalities:

a) As to claim 2, the phrase "the step of obtaining data comprises the step of obtaining data comprising an advertisement" should be **--the step of obtaining data comprises the advertisement--**; the phrase "the group consisting of a public service announcement, a legal warning, a commercial" should be **--the group consisting of a public service announcement, a legal warning, and a commercial--.**

b) As to claim 6, the phrase "combining a hash result" should be – **combining the hashed result--.**

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The apparatus recites comprising a digital rights management module and a rendering module. According to the specification, paragraphs 0010, 0013 at best indicate the modules as functional descriptive material per se. Claim 13 lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. Claims 14-16 depend on claim 13 and are rejected by a similar rationale applied against claim 13.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 8-9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Shamoon et al. (7,233,948).

a) As to claim 8, Shamoon discloses a method for preparing an advertisement message, the method comprising steps of: creating an advertisement (Shamoon: col. 4, lines 43-47); and deriving a content encryption key (CEK) from the advertisement, the content encryption key being utilized to decrypt an encrypted digital content, wherein the CEK is only obtainable after rendering the advertisement (Shamoon: col. 12, lines 37-45).

b) As to claim 9, Shamoon discloses the method of claim 8, further comprising step of: prepending the advertisement message containing the CEK to the encrypted digital content; and transmitting the advertisement message containing the CEK and the digital content (Shamoon: col. 19, lines 47-58).

c) As to claim 17, Shamoon discloses an apparatus comprising: digital content; an advertisement used to derive a content encryption key from the advertisement; and logic circuitry for deriving the content encryption key form the advertisement and encrypting the digital content with the content encryption key (Shamoon: col. 7, lines 20-21, 52-53; col. 12, lines 21-32, 37-45).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1, 3-6, 13, 15-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamoon et al. (7,233,948) in view of Tam et al. (2003/0068043).

a) As to claims 1 and 13, Shamoon discloses a method for rendering encrypted digital content, the method comprising steps of: obtaining data comprising an advertisement and encrypted digital content (Shamoon: col. 7, lines 20-21, 52-53; col. 12, lines 21-32); rendering the advertisement; deriving a content encryption key from the rendered advertisement; utilizing the content encryption key to decrypt the encrypted digital content; and rendering the digital content (Shamoon: col. 12, lines 37-45). Shamoon is silent on the capability of having the rendererd advertisement contains information necessary to derive a content encryption key. Tam is relied on for the teaching of having the rendered advertisement contains information necessary to derive a content encryption key (i.e. the restricted section is encrypted where KEY_control is the quality control information that must be provided to decrypt the data subsequently, the quality informaiton KEY_control may be provided by the output of a hashing function that operates on the advertisement and trial sections, Tam: 0059-0060, 0062, 0069-0070).

t would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of the rendererd advertisement contains information necessary to derive a content encryption key in the system of Shamoon, as Tam discloses, so as to secure advertising material for commercial reasons (Tam: 0003).

b) As to claim 3, the combination of Shamoon and Tam discloses a method of claim 1, further comprising step of insuring that the advertisement is completely rendered prior to rendering the digital content (Shamoon: col. 12, lines 37-45).

c) As to claims 4-5, 15-16 and 18, the combination of Shamoon and Tam discloses the method of claim 1 and hashing algorithm may be keyed or unkeyed (Shamoon: col. 60, lines 46-50). It further discloses using the hashing algorithm on advertisement to derive the content encryption key (i.e. Key_control is generated by hashing the advertisement, Tam: 0062, 0064).

d) As to claim 6, the combination of Shamoon and Tam discloses the method of claim 1, comprising a step of hashing the advertisement (Tam: 0062, 0064) to derive the content encryption key. It is silent on the capability of combining a hash result with a public key, however it would be a design choice of combining a hash result with any other arbitrary parameter like a public key.

11. Claims 2, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamoon et al. (7,233,948) in view of Tam et al. (2003/0068043) and further in view of Stettner (2002/0104090).

The combination of Shamoon and Tam discloses the method of claim 1, however it is silent on the capability of having the advertisement comprises information taken form the group consisting of a public service announcement, a legal warning, and a commercial. Stettner is relied on for the teaching of having the advertisement comprises

information taken form the group consisting of a public service announcement, a legal warning, and a commercial (Stettner: 0049).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the advertisement comprises information taken form the group consisting of a public service announcement, a legal warning, and a commercial in the system of Shamoon and Tam, as Stettner teaches so as to effectively provide advertisements to customers (Stettner: 0005, 0008).

12. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamoon et al. (7,233,948) in view of Tam et al. (2003/0068043) in view of Kovac et al. (6,988,277).

The combination of Shamoon and Tam discloses the method of claim 1 further comprising steps of receiving a DRM rules file (Shamoon: Abstract). However it is silent on the capability of analyzing the DRM rules file to determine a length of advertisement. Kovac is relied on for the teaching of analyzing the DRM rules file to determine a length of advertisement (Kovac: col. 2, lines 21-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of analyzing the DRM rules file to determine a length of advertisement in the system of Shamoon and Tam, as Kovac teaches, so as to provide an efficient advertisement sponsored content distribution (Kovac: col. 1, lines 13-17).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MinhDieu Nguyen
Patent Examiner
1/3/08